

REMARKS

Claims 1-26, 40-52 were previously cancelled. Claims 27-30, 33, 35-39, 53-59, 63, and 65 and 39 are pending. Claims 56, 57, 58, and 63 are amended. Support for the amendment to Claims 56, 57, 58, and 63 can be found throughout the specification, particularly pages 4-9. The amendment to Claims 57 and 58 are to correct minor typographical errors. The amendment to Claims 56 and 63 are to overcome 35 U.S.C. § 112. Claims 31, 32, 34, and 64 are withdrawn. Originally, claims 32, 35, and 36 were provisionally withdrawn. Applicants herein re-assert the previous traversal of the election of the species requirement. The Examiner is respectfully reminded to rejoin the non-elected species when the allowable subject matter has been determined.

1. Rejection of Claims 54, 56 and 63 under 35 U.S.C. § 112.

The rejection of Claims 54, 56 and 63 under 35 U.S.C. § 112, first paragraph, is believed to be obviated by the amendment above. Accordingly, Applicants respectfully request withdrawal of this ground of rejection.

2. Rejection of Claims 27-30, 37, 39, 53, 54, 56-59 and 63 under 35 U.S.C. § 102 (b) as being anticipated by WO 99/63157.

The independent claim 27 recites "A paper or paperboard having a basis weight that is greater than or equal to about 80 pounds per 3000 square feet and comprising a base layer comprising cellulosic fibers; an ink receptive layer comprising at least one member selected from the group consisting of an acrylic polymer and a biocide; and a holdout layer that is disposed between the base layer and the ink receptive layer, wherein the holdout layer comprises starch." (Emphases added). As recited in the claim 27, the present invention is directed to a coating additive applied to a paper that produces different results than the coating additives applied to a paper disclosed by the WO 99/63157. For example, the ink

receptive layer recited in claim 27 is used on a paper to prevent smudge or feathering of ink to the paper. In addition, the starch in claim 27 is used to penetrate partially into the sheet of paper and is bound into the fiber of the base layer. On the contrary, the ink receptive layer disclosed by WO 99/63157 is used for printing applications (i.e., catalog papers, publishing papers) such as flexo, offset or ink jet printing papers. Examiner's attention is directed to page 13, Example 14, in WO 99/63157 which clearly disclose that "two papers were prepared.....the coating affords a high gloss, enamel grade publishing paper". Moreover, WO 99/63157 does not teach or disclose a hold layer as it is used and recited in the claim 27 of the present invention. As noted, the teaching in WO 99/63157 is different to what the present invention teaches and recites in the claim 27. Since claim 27 is not identically taught or described in WO 99/63157, then claim 27 is not anticipated by the cited reference. Therefore, claim 27 defines a patentable subject matter and claims 28-30, 32, 33, 35-39, 53-59, 63, and 65 are dependent directly or indirectly upon claim 27 and therefore inherit each and every element of the parent claim and any intervening claim(s). Applicants respectfully request withdraws of the rejection.

3. Rejection of Claims 33, 38, 55 and 65 under 35 USC § 103(a) as being unpatentable over WO 99/63157.

Claims 33, 38, 55 and 65 are directly dependent on the independent claim 27. The inapplicability of WO 99/63157 to the patentability of Claim 27 is noted hereinabove and attention is invited to such discussions. Therefore, claim 27 defines a patentable subject matter and each of claims 33, 38, 55 and 65 is dependent directly upon the claim 27 and therefore inherits each and every element of their parent claim and any intervening claim(s).

In light of the above, Applicants can only believe that the Examiner is reading the Applicants' own specification and using hindsight to modify the disclosure of WO 99/63157.

This is forbidden. See *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. From the above, WO 99/63157 clearly fails to explicitly or implicitly disclose or motivate the skilled artisan to modify its own disclosure towards that of the claimed invention. Further, the Office has failed to specifically demonstrate that such motivations to modify WO 99/63157 towards the claimed invention would have come from someplace else (i.e. there is no evidence demonstrating that the skilled artisan would inherently possess such motivation). Accordingly, WO 99/63157 fails to disclose or suggest the claimed invention. Applicants respectfully request withdrawal of this ground of rejection.

3. Rejection of Claims 27-30, 33, 35-39, 53-59, 63 and 65 under 35 USC § 103(a) as being unpatentable over JP 08-337078.

The abstract of JP 08-337078 neither teaches, suggests, nor discloses a holdout layer as recited in the claim 27 of the present invention. This abstract is not enabled and therefore, fails to disclose the subject matter recited in the claim 27 of the present invention. Again, as noted above, The Applicants assert that the Examiner has improperly engaged in hindsight reconstruction in order to find the claimed invention obvious, using the present invention as a guide. Therefore, claim 27 defines a patentable subject matter and each of claims 28-30, 33, 35-39, 53-59, 63 and 65 is dependent directly upon claim 27 and therefore inherits each and every element of their parent claim and any intervening claim(s). This rejection is inappropriate and should be withdrawn.

4. Rejection of Claims 60-62 under 35 USC § 103(a) as being unpatentable over JP 08-337078 in view of EP 880892.

Claims 60-62 are directly dependent on the parent claim 27. The inapplicability of JP 08-337078 to the patentability of claim 27 is noted hereinabove and attention is invited to such discussions.

Thus, irrespective of what EP 880892 teaches with respect to the chemistry that is used in the paper coatings, the failure of JP 08-337078 as a primary reference negates the combination of JP 08-337078 in view of EP 880892 as a basis for rejection of dependent claims 60-62 of the present claimed invention. Therefore, this rejection is inappropriate and should be withdrawn.

CONCLUSION

Therefore, Applicants respectfully submit that the amended independent claim 27 particularly define and patentably distinguish the present invention over the cited references. In addition, all of the dependent claims which depend from claim 27 also define a patentable subject matter. Accordingly, reconsideration of the rejections and allowance of claims 28-30, 33, 35-39, 53-59, 63 and 65 is earnestly requested. However, should the Examiner have any remaining questions and the attending to of which would expedite such action, the Examiner is invited to contact the undersigned at the telephone number listed below.

Three months extension of time is believed to be required. The Commissioner is authorized to charge any fees associated with this or any other communication, or credit any over payment, to Deposit Account No. 09-0525.

Respectfully submitted,

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